

## INTERFERENCE DIGEST

Interference No. 105,496

Paper No.

Name: Dean Engelhardt et al.

Serial No.: 08/486,069

Patent No.

Title: Nucleic acid sequencing processes using non-radioactive detectable modified or labeled Nucleotides or nucleotide analogs, and other processes for nucleic acid detection and chromosomal characterization using such non-radioactive detectable modified or labeled nucleotides or nucleotide analogs

Filed: 06/07/95

Interference with Smith et al.

### DECISION ON MOTIONS

Administrative Patent Judge, \_\_\_\_\_ Dated, \_\_\_\_\_

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### FINAL DECISION

Board of Patent Appeals and Interferences, \_\_\_\_\_ Dated, \_\_\_\_\_

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Court, \_\_\_\_\_ Dated, \_\_\_\_\_

### REMARKS

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This should be placed in each application or patent involved in interference in addition to the interference letters.



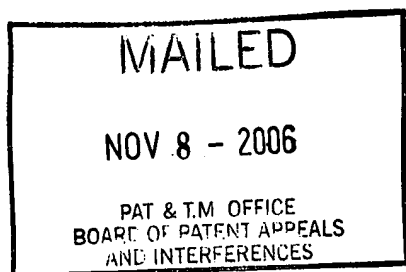
PAPER NO.

## UNITED STATES PATENT AND TRADEMARK OFFICE

DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BOARD OF PATENT APPEALS AND INTERFERENCES  
BOX INTERFERENCE, WASHINGTON, D.C. 20231

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Filed by: Judge Richard Torczon  
Telephone: 571-272-4683  
Facsimile: 571-273-0042



Applicants: ENGELHARDT  
Application No.: 08/486,069  
Filed: 06/07/95

For: Nucleic acid sequencing processes using modified nucleotides or nucleotide analogs, and other processes for nucleic detection and chromosomal characterization using such modified nucleotides or nucleotide analogs

The above-identified application or patent has been forwarded to the Board of Patent Appeals and Interferences because it is adjudged to interfere with another application or patent. An interference has been declared. The interference is designated as No. 105,496.

Notice is hereby given the parties of the requirement of the law for filing in the Patent and Trademark Office a copy of any agreement "in connection with or in contemplation of the termination of the interference." 35 U.S.C. § 135(c).

/Richard Torczon/  
RICHARD TORCZON  
Administrative Patent Judge

ON BEHALF OF THE DIRECTOR OF THE  
UNITED STATES PATENT AND TRADEMARK OFFICE

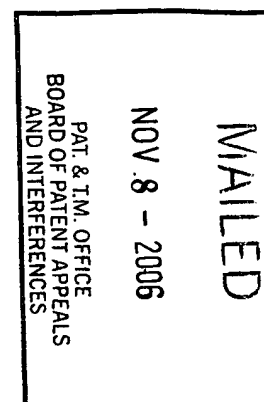
Patent Interference No. 105,496 (RT)  
(From Technology Center 1600)

CALIFORNIA INSTITUTE OF TECHNOLOGY  
(5,821,058),<sup>1</sup>  
Junior Party,

v.

ENZO DIAGNOSTICS, INC.  
(08/486,069),<sup>2</sup>  
Senior Party.

DECLARATION - Bd.R. 203(b)<sup>3</sup>



TORCZON, Administrative Patent Judge.

1       A.     Declaration of interference

2       An interference is declared pursuant to 35 U.S.C. 135(a). Details of the applications,  
3 count, and claims designated as corresponding to the count appear under headings E and F of this  
4 DECLARATION.

5       B.     Designation to manage

6       Administrative Patent Judge Richard Torczon has been designated to manage the  
7 interference. Bd. R. 104(a).

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<sup>1</sup> Docket # 243132000104.

<sup>2</sup> Docket # Enz-5(D8)(C2).

<sup>3</sup> "Bd.R. x" may be used as shorthand for "37 C.F.R. § 41.x". 69 Fed. Reg. 49960, 49961 (12 Aug. 2004).

1 C. Standing order

2 A copy of the Trial Section STANDING ORDER [SO] (Paper 2) accompanies this  
3 DECLARATION. The STANDING ORDER applies to this contested case.

4 D. Conference call to set dates

5 A telephone conference call to set dates for action in this contested case is scheduled for  
6 2 p.m. (Eastern) on 10 January 2007. (The Board will initiate the call.)

7 No later than 8 January 2007, each party shall file and serve (SO ¶¶ 10.1 & 105) a list of  
8 the motions (Bd. R. 120; Bd. R. 204; SO ¶¶ 104.2.1, 120 & 204) the party intends to file.

9 A sample schedule for taking action during the motion phase appears as Form 2 in the  
10 STANDING ORDER. Counsel are encouraged to discuss the schedule prior to the conference  
11 call and to agree on dates for taking action. A typical motion period lasts approximately eight (8)  
12 months. Counsel should be prepared to justify any request for a shorter or longer period.

13 E. The parties to this interference14 Junior Party

15 Patent: 5,821,058

16 Title: Automated DNA sequencing technique

17 Inventors: Lloyd M. Smith of Madison, Wisconsin; Leroy E. Hood of Seattle, Washington;  
18 Michael W. Hunkapiller of San Carlos, California; Tim J. Hunkapiller of  
19 Seattle, Washington; and Charles R. Connell of Redwood City, California

Senior Party

Application: 08/486,069

Title: Nucleic acid sequencing processes using modified nucleotides or nucleotide analogs, and other processes for nucleic acid detection and chromosomal characterization using such modified nucleotides or nucleotide analogs

Inventors: Dean Engelhardt of New York City, Elazar Rabbani of New York City, Stanley Kline of Brooklyn, Jannis G. Stavrianopoulos of New York City, and Dollie Kirtikar of Elmhurst, all of New York

F. Count and claims of the parties

Count 1

The method of 5,821,058 claim 14.

The claims of the parties are:

Caltech: 1-56

Enzo: all<sup>4</sup>

The claims corresponding to Count 1:

Caltech: 1-56

Enzo: all

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<sup>4</sup> The Enzo claims are so numerous and erratically numbered that this declaration adopts the expedient of referring to the source rather than risk the likelihood of misstating the claims. A copy of the Enzo claims is attached as an appendix. A last minute paper from Enzo suggests cancellation of some of the claims without prejudice. Given the great age of the Enzo application, the suggestion is declined on those terms since it could leave a considerable number of complex estoppel issues unresolved in any subsequent examination. Nevertheless, the suggestion to simplify issues in the interference is appreciated.

Enzo's claims, as prosecuted, are extraordinary in their flagrant disregard of 35 U.S.C. 112(5) and 37 C.F.R. § 1.75. Although the examiner has a responsibility to enforce the statute and the rules, Enzo drafted and filed the claims and thus bears the ultimate responsibility for their defects. Enzo is hereby on notice that the carelessness and propensity for needless complexity evident from its claims will not be tolerated during the interference.

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1           G.    Heading to be used on papers; exhibit numbers

2           Addendum 1 provides the heading that shall be used on all papers filed in the contested  
3 case. See SO ¶ 106.1.1.

4           The range of exhibit numbers is assigned as follows (Bd.R. 154(c)(1); SO ¶ 154.2.1):

5                 Enzo:    1001-1999.

6                 Caltech: 2001-2999.

7           H.    Order form for requesting file copies

8           When requesting copies of files, use of Addendum 2 (SO Form 4) will greatly expedite  
9 processing of the request. Please attach a copy of Parts E and F of this DECLARATION with a  
10 hand-drawn circle around the patents and applications for which a copy of a file wrapper is  
11 requested.

Attachment: Copy of the application<sup>5</sup> claims for 08/486,069

Enclosure: Copy of STANDING ORDER (Paper 2)

cc (overnight delivery):

For the California Institute of Technology: M. Paul Barker, MORRISON & FOERSTER LLP, of Palo Alto, California.

For Enzo Biochem, Inc.: Ronald C. Fedus, ENZO BIOCHEM, INC., with Eugene C. Rzucidlo, HUNTON & WILLIAMS, both of New York City, New York.

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<sup>5</sup> Any United States patent listed in this paper is available at <http://patft.uspto.gov/>.

**ADDENDUM 1**

Filed on behalf of: [Name of Party]  
By: [Name of lead counsel  
Name of backup counsel  
Street address  
City, State, and ZIP Code  
Tel:  
Fax: ]

Paper No. [Leave blank]

UNITED STATES PATENT AND TRADEMARK OFFICE  
BOARD OF PATENT APPEALS AND INTERFERENCES

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Patent Interference No. 105,496 (RT)

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CALIFORNIA INSTITUTE OF TECHNOLOGY  
(5,821,058),  
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TITLE OF PAPER



**ADDENDUM 2**

**FILE COPY REQUEST**  
Patent Interference No. 105,496

Attach a copy of sections E and F of this DECLARATION to this REQUEST. On the copy, circle each patent and application that you are requesting. Include the following information to facilitate processing of this REQUEST:

1. Charge fees to USPTO Deposit Account No. \_\_\_\_\_
2. Complete address,<sup>6</sup> including street, city, state, ZIP code, and telephone number:  
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3. Telephone, including area code: \_\_\_\_\_

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<sup>6</sup> Provide a street address, NOT a Post Office Box. The Office of Public Records uses a commercial overnight delivery service rather than the United States Postal Service to deliver file copies.